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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Daniel Garfinkel, et al.

Confirmation No.: 1066

Application No.: 09/687,774

Examiner: M. J. Ludwig

Filing Date: 10-13-2000

Group Art Unit: 2178

Title: METHOD AND SYSTEM FOR CAPTURING, STORING, SHARING AND MANAGING
NOTES TAKEN DURING A COMPUTER BASED MEETING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in **triplicate** is the Reply Brief with respect to the Examiner's Answer mailed on June 2, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,

Daniel Garfinkel, et al.

By

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Docket No.: 10001114-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Daniel Garfinkel et al.

Application No.: 09/687,774

Confirmation No.: 1066

Filed: October 13, 2000

Art Unit: 2178

For: METHOD AND SYSTEM FOR CAPTURING,
STORING, SHARING AND MANAGING
NOTES TAKEN DURING A COMPUTER
BASED MEETING

Examiner: M. J. Ludwig

REPLY TO EXAMINER'S ANSWER UNDER 37 CFR 1.193(B)

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This Reply is in response to the Examiner's Answer mailed June 2, 2005 (hereinafter "Examiner's Answer"). Appellant respectfully requests withdrawal of the final rejection, re-opening of prosecution, and allowance of the above-captioned application. Should the Primary Examiner not find the comments contained herein persuasive, acknowledgment of receipt and entry of this Reply Brief is requested.

REPLY ARGUMENTS

Appellant responds herein to the Examiner's reference to 37 CFR 1.192(c)(7) and the rejection under 35 U.S.C. § 103. Based on a review of the Examiner's Answer, it appears that the rejection under 35 U.S.C. § 103 is based on a mischaracterization of the limitations in claims 1-20 and a misapplication of the teachings of Kumar et al., U.S. Patent Application

6,342,906 (hereinafter Kumar). For the reasons set forth below, Appellant requests the Board of Patent Appeals and Interferences (the "Board") reverse the Examiner's rejections in the event that the rejections are not withdrawn prior to reaching the Board.

37 CFR 1.192(c)(7) Is Inoperative

On page 2 of the Examiner's Answer, section 8 states:

The rejection of claims 1-20 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The Appellant respectfully points out, however, that 37 CFR 1.192 is now inoperative, having been replaced in 2004 with § 41.37. See Federal Register, Vol. 69, No. 155, at 50006. § 41.37(c)(1)(vii) states, in pertinent part:

When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

The Appellant respectfully points out that Appellant's Appeal Brief argued claims 1, 2, 5 and 13, 7 and 15, and 9 and 17 separately. Thus, claims 1-20 do not stand or fall together.

The Examiner's Answer Mischaracterizes The Limitations of Claims 1-20, and Misapplies the Teaching of the Cited Art

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar. In the Appeal Brief, the Appellant pointed out that To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Royka*, 180 USPQ 580 (CCPA 1974). The Appeal Brief then demonstrated that the rejection of claims 1-20 did not satisfy these criteria.

Claim 1

Claim 1 recites, in part:

- a note creation module which captures an electronic note associated with a change in a three-dimensional model of said CAD application;
- a note storage module which stores said captured note and an associated data file for later retrieval; and
- a note retrieval module for retrieving and displaying said captured note with a display screen of said three-dimensional model, that existed when said note was generated, using said associated data file.

As recited in the claim, the captured note is separate and distinct from the three-dimensional model of the CAD application. A functional relationship between the note and the CAD application is recited in the note storage module and the note retrieval module. Specifically, the note storage module (in addition to storing the note) stores a data file that is subsequently used by the note retrieval module to display a display screen of the CAD model that existed when the note was generated.

In the Examiner's Answer, the Examiner attempts to support the rejection by stating, "as presently claimed, the only requirement for a data file is that it is somehow associated with the note." *See* Examiner's Answer at 8. However, this is a mischaracterization of claim 1 that weakens the Examiner's position. In contrast to the Examiner's contention, claim 1 requires far more of a "data file" than the Examiner suggests. Claim 1 requires a "data file" to be used by a "note retrieval module for retrieving and displaying said captured note with a display screen of said three-dimensional model, that existed when said note was generated." As demonstrated during prosecution and in the Appeal Brief, Kumar does not teach or suggest this limitation. Moreover, the Examiner has never claimed that it does.

Kumar is merely directed to a system that facilitates collaboration across remote sites according to two different modes of operation. *See* Abstract. In one mode of operation (the "edit mode"), users are allowed to edit data associated with an ordinary application (e.g., a spreadsheet application). *See* col. 4, lines 24-32. In the other mode of operation (the

“annotation mode”), users are allowed to make annotations that are displayed over the top of the underlying application. For example, a user may “circle” an entry in a spreadsheet to enable discussion of that entry during the collaboration session. The annotations occur in a manner that is transparent to the underlying application, e.g., “circling” a spreadsheet entry in the annotation mode has no effect on the spreadsheet file. *See* col. 4, lines 11-23 and FIGURE 2.

First, Appellant respectfully submits that there are no note storage modules or note retrieval modules in Kumar. The functionality supporting the annotation screen in Kumar cannot satisfy these limitations, because the annotation screen is only maintained during a collaboration session. There is no teaching or suggestion that an annotation screen can be retrieved at a later time. In regard to the application file that is editable by the Kumar system, Kumar merely discloses that the application file can be “a three-dimensional view” or any other custom data. *See* col. 3, lines 46-49. However, there is no teaching or suggestion associated with the application files of Kumar of a note creation module which captures an electronic note associated with a change in a three-dimensional model of a CAD application. Likewise, there is no teaching or suggestion associated with the application files of Kumar of a note storage module or a note retrieval module.

Moreover, there is no functional relationship taught or suggested by Kumar between storing and retrieving notes and associated data files. The only relevant data structures discussed in Kumar are the file associated with the underlying application and the data structure maintaining the graphical annotation data. However, the underlying application data file of Kumar cannot address the claimed subject matter, because the application data file will not enable the user to view a display of “a three-dimensional model that existed when said note was generated using said associated data file.” Specifically, once a user makes a change to the underlying application file using the edit mode of Kumar, the prior version of the application file is no longer available. The annotation data of Kumar merely stores the user annotations and similarly does not enable the user to view a display of “a three-dimensional model that existed when said note was generated using said associated data file.”

Accordingly, a prima facie case of obviousness has not been established for claim 1. Claims 2-4 depend from claim 1 and, hence, inherit all limitations of claim 1. A prima facie case of obviousness has not been established for claims 2-4.

Claim 2

Claim 2 recites “wherein said note retrieval module receives a query condition and retrieves said captured note and associated data file if said note meets said query condition.”

During prosecution, the Examiner asserted that Kumar suggests the limitation of claim 2, because a user of the Kumar system can choose to work on either the annotation layer or the application workspace. *See* Office Action, dated July 8, 2004, page 3. The Examiner further supports this position by now contending:

[Kumar] discloses the control modifications can change the available options on the display bar of the input layer. The control modifications can change and/or restrict the modes available to any client. The process begins by retrieving the user input in. The reference suggests query conditions for the retrieval of user input and new segments within the note retrieval methods of Kumar.

See Examiner’s Answer at 9. However, a “query” is a known database term that defines information to be retrieved. *See* Appeal Brief at 6 (citing application, page 2, lines 14-17). The disclosure of Kumar does not teach or suggest using queries as recited by claim 2, and the Examiner’s position appears to be limited to an opinion that “user input” could be modified to meet a “query condition.” However, even if true, the disclosure of Kumar relied upon by the Examiner makes no mention of how “user inputs” could be modified to be a query condition, no reference has been offered as a source for teaching how “user inputs” could be modified to be a query condition, and no motivation has been offered for why one of ordinary skill in the art would have modified Kumar in such a way. Thus, no prima facie case has been established for making the rejection of claim 2.

Claims 5 and 13

Claim 5 recites, in part,

capturing a note in a note object; and
associating a data file with said captured note, wherein said data file is used to generate a display of a three-dimensional model of said CAD application that existed when said note was captured.

Claim 13 recites, in part,

capturing a note in a note object; and
associating a data file with said captured note, wherein said data file is used to generate a display of a three-dimensional model of said CAD application that existed when said note was captured.

As recited in claims 5 and 13, the captured note is separate and distinct from the three-dimensional model of the CAD application. A functional relationship between the note and the CAD application is recited. Specifically, the functional relationship between the note capturing and the CAD application is defined by associating a data file with the captured note whereby the data file is used to generate a display of the three-dimensional model of the CAD application that existed when the note was captured.

In the Examiner's Answer, the Examiner attempts to support the rejection by stating, "the data file stated within the limitations of both claims do not preclude the prior art features from utilizing the underlying data file associated with the different types of application that could be used to provide a means of associating a note and displaying a modified drawing or three dimensional view, or any other type of custom data." *See* Examiner's Answer at 9. However, this statement demonstrates the fundamental flaw in the Examiner's logic, as it appears to contend that nothing prohibits the teachings of Kumar from being modified to perform the limitations of the rejected claims. Claims 5 and 13 require a "data file" to be "used to generate a display of a three-dimensional model of said CAD application that existed when said note was captured." Regardless of whether or not the teachings of Kumar could be modified to perform this limitation, and the Appellant does not concede that they can be, the Appellant respectfully points out that to meet the limitations of the claims the teaching of Kumar must first be *modified*. Even if true, the disclosure of Kumar relied upon by the Examiner makes no mention of how, no reference has been offered as a source for teaching modifications, and no motivation has been offered for why one of ordinary skill in the art would have modified Kumar in the first place.

Kumar is merely directed to a system that facilitates collaboration across remote sites according to two different modes of operation. *See* Abstract. In one mode of operation (the “edit mode”), users are allowed to edit data associated with an ordinary application (e.g., a spreadsheet application). *See* col. 4, lines 24-32. In the other mode of operation (the “annotation mode”), users are allowed to make annotations that are displayed over the top of the underlying application. For example, a user may “circle” an entry in a spreadsheet to enable discussion of that entry during the collaboration session. The annotations occur in a manner that is transparent to the underlying application, e.g., “circling” a spreadsheet entry in the annotation mode has no effect on the spreadsheet file. *See* col. 4, lines 11-23 and FIGURE 2.

There is no functional relationship taught or suggested by Kumar between storing and retrieving notes and associated data files. The only relevant data structures discussed in Kumar are the file associated with the underlying application and the data structure maintaining the graphical annotation data. However, the underlying application data file in Kumar cannot address the claimed subject matter, because the application data file will not enable the user to view a display of “a three-dimensional model of said CAD application that existed when said note was captured.” Specifically, once a user makes a change to the underlying application file using the edit mode of Kumar, the prior version of the application file is no longer available. The annotation data in Kumar merely stores the user annotations and similarly does not enable the user to view a display of “a three-dimensional model of said CAD application that existed when said note was captured.”

Accordingly, a *prima facie* case of obviousness has not been established for claims 5 and 13. Claims 6-12 and 14-20 respectively depend from base claims 5 and 13 and, hence, inherit all limitations of their base claim. A *prima facie* case of obviousness has not been established for claims 6-12 and 14-20.

The arguments presented by the Examiner’s Answer for the remaining claim groups remains unchanged from those forwarded during prosecution. These arguments have been fully traversed by Appellant’s Appeal Brief, and thus, for the sake of brevity, the Appellant refers the Board to the arguments presented there.

Conclusion

For the reasons presented herein, Appellant respectfully requests the Board to rule that the pending claims are allowable over the cited reference.

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